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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/355,014	09/13/1999	VANESSA HSEI	P1085R3	5890

7590 05/03/2002

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EXAMINER
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HELMS, LARRY RONALD

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 05/03/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/355,014

Applicant(s)

HSEI ET AL.

Examiner

Larry R. Helms

Art Unit

1642

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 January 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 13 March 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): ODP over 09/234182, 102(e) rejection.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-34

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

10. ☐ Other: \_\_\_\_\_

*Sheela Hoff*  
SHEELA HOFF  
PRIMARY EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because: The response filed 1/11/02 has been carefully considered but is deemed not to be persuasive. The response argues that Faanes et al does not teach antibody fragments, however, Faanes et al teaches fragments at column 10, lines 8-13. The response also argues that there is no teachings or suggestion to make conjugates of the apparent size in claim 1. In response to this argument, Faanes et al teach conjugates of molecular weight 540 kD and increases in the apparent molecular weight by increases in the PEG conjugates. It would be obvious that when using higher molecular weight PEG, as Faanes teaches, the apparent size of the conjugate would be increased accordingly (see column 19, lines 23-41) when higher MW PEG was added thus leading to at least 8-25 fold greater apparent size compared to the antibody fragment. In addition with regard to the Zapata et al reference, the application 09/121,959 was not available for inspection, however, Zapata et al (FASEB J 9;A1476, 1995) also teach reduced clearance and a 10kD PEG worked better than the 5kD PEG, therefore it would be obvious to use a higher MW PEG and as such in view of Faanes et al which teaches 40Kd one skill in the art would use a higher MW to get better clearance and as such this would increase the apparent MW of the conjugate to those recited in the claims. The response further argues that the other references do not cure the deficiency of the Faanes et al reference. In addition it is noted that there is no 1449 in this case for references which were stated to be provided in 09/121,952. 09/121,952 was unavailable for inspection. If the 1449 and the references are provided the Examiner will consider them at that time.